

REMARKS

I. Introduction

Claims 33 to 65 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are in allowable condition.

II. Rejection of Claims 33 to 65 under 35 U.S.C. § 103(a)

Claims 33, 55, and 57-58 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 0 726 508 (Frampton; hereinafter referred as the “EP reference”) in view of Greszczuk (U.S. Patent No. 6,445,703). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Initially, Applicants note that Greszczuk is not a valid prior art reference against the present application. The present application has the earliest effective priority date of November 13, 1998 for the purpose of analyses involving references which allegedly qualify as prior art under 35 U.S.C. §§ 102(a) and 102(e)¹, and the earliest effective U.S. filing date of September 10, 1999 for the purpose of analysis involving reference which allegedly qualify as prior art under 35 U.S.C. § 102(b). Greszczuk issued on September 3, 2002, and the parent PCT application was published on August 3, 2000, both of which dates are after the present

¹ Since both the present application and Greszczuk have PCT filing dates prior to November 29, 2000, pre-AIPA § 102(e) analysis is applicable.

application's effective U.S. filing date of September 10, 1999, and well after the present application's earliest invention date of November 13, 1998. Accordingly, Greszczuk is clearly not a valid prior art reference against the present application under 35 U.S.C. §§ 102(a) or 102(b). Furthermore, the earliest effective date of Greszczuk as applied against the present application under 35 U.S.C. § 102(e) is June 13, 2000, which date is well after the present application's earliest effective priority date of November 13, 1998. To the extent the Examiner may be mistakenly relying on the provisional application filing date of January 26, 1998 for the Greszczuk reference, Applicants note that the provisional application date of Greszczuk does not change the effective 102(e) date for Greszczuk. (See, e.g., MPEP 706.02(f)(1)(example 6); and MPEP 2136.03 III). Accordingly, Greszczuk is clearly not a valid prior art reference against the present application under 35 U.S.C. § 102(e). Therefore, Greszczuk is not a valid prior art reference against the present application.

In addition to the above, Applicants note that the Examiner has conceded that the EP reference does not teach or suggest the claimed feature of "causing the communication terminals to analyze the synchronization information in at least the second operating mode," as recited in claim 33. Since Greszczuk is not a valid prior art reference, and since the EP reference does not teach or suggest all of the claimed features of claim 33, Applicants submit that the rejection of claim 33 and its dependent claims 55, 57 and 58 should be withdrawn.

Claims 34-35 and 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over the EP reference and U.S. Patent No. 6,356,538 ("Li") or in the alternative Greszczuk. Claims 34-35 and 50-51 depend on claim 33. As noted above, the Examiner has conceded that the EP reference does not teach or suggest the claimed feature of "causing the communication terminals to analyze the synchronization information in at least the second operating mode," as recited in claim 33. Furthermore, Li fails to cure the deficiencies of the EP reference as applied against parent claim 33, and Greszczuk is not a valid prior art reference. Therefore, claims 34-35 and 50-51 are not rendered obvious by the combination of the EP reference, Li and Greszczuk.

Claims 36-43, 45, 48-49, 56 and 59-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over the EP reference and Li and further in view of Greszczuk et al. Claims 36-43,

45, 48-49, 56 and 64-65 ultimately depend on claim 33. Claim 59 recites substantially similar features as the above-discussed feature of claim 33, i.e., claim 59 recites that “the terminal analyzes synchronization information during at least one of the second and third operating modes.” Claims 60-63 depend on claim 59. As noted above, the EP reference does not teach or suggest the claimed feature of “causing the communication terminals to analyze the synchronization information in at least the second operating mode,” as recited in claim 33, or the claimed feature that “the terminal analyzes synchronization information during at least one of the second and third operating modes,” as recited in claim 59. Furthermore, Li fails to cure the deficiencies of the EP reference as applied against parent claims 33 and 59, and Greszczuk is not a valid prior art reference. Therefore, claims 36-43, 45, 48-49, 56 and 59-65 are not rendered obvious by the combination of the EP reference, Li and Greszczuk.

Claims 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of the EP reference and Greszczuk in view of U.S. Patent No. 5,606,313 (“Allen”). Applicants note that claims 46-47 ultimately depend on claim 33. As noted above, the Examiner has conceded that the EP reference does not teach or suggest the claimed feature of “causing the communication terminals to analyze the synchronization information in at least the second operating mode,” as recited in claim 33. Furthermore, Allen fails to cure the deficiencies of the EP reference as applied against parent claim 33, and Greszczuk is not a valid prior art reference. Accordingly, the combination of the EP reference, Greszczuk and Allen fails to render obvious claims 46-47.


Claims 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of the EP reference and Greszczuk in view of U.S. Patent No. 5,794,137 (“Harte”). Applicants note that claims 52-54 ultimately depend on claim 33. As noted above, the Examiner has conceded that the EP reference does not teach or suggest the claimed feature of “causing the communication terminals to analyze the synchronization information in at least the second operating mode,” as recited in claim 33. Furthermore, Harte fails to cure the deficiencies of the EP reference as applied against parent claim 33, and Greszczuk is not a valid prior art reference. Accordingly, the combination of the EP reference, Greszczuk and Harte fails to render obvious claims 52-54.

III. Conclusion

In view of the above amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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